b) a plurality of light emitting diodes arranged about and attached to the visible exterior surface of each strip light emitting diode light source; and

c) a controller in electric communication with the light emitting diodes, the controller constructed and arranged to selectively activate the light emitting diodes thereby producing at least two different types of visually distinct warning light signals, said controller being further constructed and arranged to produce the at least two different types of visually distinct warning light signals in at least one sequence of light signals, said light emitting diodes receiving power from a power source.

35. (New) The combination of claim 34, said sequence of light signals comprising alternating illumination of at least two of said visually distinct warning light signals.

36. (New) The combination of claim 34, wherein said sequence of light signals is repeating.

37. (New) The combination of claim 34, said sequence of light signals comprising random illumination of said light signals.

38. (New) The combination of claim 34, said sequence of light signals comprising repeated illumination of one of said visually distinct warning light signals for at least two occurrences.

39. (New) The combination of claim 34, wherein said at least two different types of visually distinct warning light signals are illuminated in any combination to form said sequence.

40. (New) The combination of claim 34, wherein three or more visually distinct warning light signals are generated in a regular sequence.

41. (New) The combination of claim 34, wherein three or more visually distinct warning light signals are generated in an intermittent sequence.

42. (New) The combination of claim 34, wherein three or more visually distinct warning light signals are generated in an irregular sequence.

REMARKS

Applicant is providing a response to the Office Action of September 17, 2002 by numbering paragraphs herein to correspond to the Office Action.

In paragraph 2, the Examiner has rejected claims based upon the non-statutory double patenting rejection pursuant to 37 C.F.R. §1.30(b) and *in re Goodman* 11 F.3rd 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993). In response to the non-statutory double patenting rejection a Terminal Disclaimer is provided herein as related to U.S. Patent No. 6,380,865 pursuant to 37 C.F.R. §3.73(b). Applicant believes that the inclusion of a Terminal Disclaimer herein overcomes the rejection as to the non-statutory double patenting as raised by the Examiner.

In paragraph 3, the Examiner has rejected claims herein based upon the non-statutory double patenting rejection pursuant to 37 C.F.R. §1.30(b) and *in re Goodman*, 11 F.3rd 1046, 29 U.S.P.Q.2d 2010 (Fed. Cir. 1993). In response to the non-statutory double patenting rejection, a Terminal Disclaimer is provided herein as related to U.S. Patent No. 6,424,269 pursuant to 37 C.F.R. §3.73(b). Applicant believes that the inclusion of a Terminal Disclaimer herein overcomes the rejection as to the non-statutory double patenting as raised by the Examiner.

In paragraph 5, the Examiner next rejected claims 1-11 and 13-21 pursuant to 35 U.S.C. §103(a) over Wang U.S. Patent No. 6,067,010 in view of Walton U.S. Patent No. 5,966,073.

With respect to 35 U.S.C. §103, the Federal Circuit has set out at least five principles regarding obviousness determinations under §103. *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 187 (Fed. Cir. 1986). In *Hodosh*, the Federal Circuit stated:

> Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying §103:
>
> (1) the claimed invention must be considered as a whole (35 U.S.C. 103; see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984) (though the difference between claimed invention and prior art may seem slight, it may also have been the key to advancement of the art));
>
> (2) the references must be considered as a whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481 488 (Fed. Cir. 1984));

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) "ought to be tried" is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026); and

(5) the presumption of validity remains constant and intact throughout litigation (35 U.S.C. 285; e.g., *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359-60, 220 USPQ 763, 770 (Fed. Cir. 1984)).

Furthermore, when an attempt is made to combine two references A and B, or to change a single reference, a prima facie case of obviousness has not been established if:

(1) A and B could not or would not be physically combined in an operative fashion to produce the desired result by a person of ordinary skill without use of the patentee's teachings. *In re Lintner*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972); *In re Regel*, 526 F.2d 1399, 199 USPQ 136 (CCPA 1975); *In re Jansson,* 609 F.2d 996, 203 USPQ 976 (CCPA 1979).

(2) The intended purpose or function of either A or B, or both, is destroyed by their combination. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

(3) No suggestion why or reasons or motivation for combining A and B appears explicitly or implicitly in either A or B, or both in combination. *In re Clinton,* 527 F.2d 1226, 188 USPQ 265 (CCPA 1976). Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent a teaching or suggestion supporting the combination. *In re Fine*, 5 USPQ 2d, 1596 (1988) (Fed. Cir. 1989); see also *In re Laskowski*, 10 USPQ 2d 1397 (Fed. Cir. 1989).

(4) A and B are from such diverse arts (i.e., either or both are nonanalogous art to the claimed invention) that a person of ordinary skill in the claimed art would not look to those arts to solve the problem treated by the claimed invention. *In re Pagliaro*, 657 F.2d 1219, 210 USPQ 888 (CCPA 1981); *In re Wood*, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979); *In re Horn*, 203 USPQ 969 (CCPA 1979).

(5) A and B do not teach the source of the problem and the recognition of the source of the problem is what is unobvious. *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 US 45 (1923); *In re Sponnoble*, 405 F.2d 578, 160 USPQ 237 (CCPA 1969); *In re Peehs*, 612 F.2d 1287,

204 USPQ 835 (CCPA 1980). *See Kayton*, 1 Patent Practice 5-28, 29 (1985).

In addition, in the recent case of *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (CAFC 1999), the Court of Appeals for the Federal Circuit has stated that the ultimate determination of whether an invention is or is not obvious is a legal conclusion based upon underlying factual inquiries including:

(1) The scope and content of the prior art;

(2) The level of ordinary skill in the prior art;

(3) The differences between the claimed invention and the prior art; and

(4) Objective evidence of non-obviousness.

The Court of Appeals for the Federal Circuit went on to state that the analysis with respect to obviousness is required to be conducted "at the time the invention was made" to guard against entry into the "tempting but forbidden zone of hindsight". The Court of Appeals for the Federal Circuit went on to state that the "very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". The Court of Appeals for the Federal Circuit has stated that the case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references and that one of ordinary skill in the art would have been motivated to select the references and combine them, and it was error to not elucidate any factual teachings, suggestions, or incentives from the prior that showed the propriety of combination. The Federal Circuit in *Dembizcak* further stated that combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability which is the essence of hindsight.

The Wang U.S. Patent No. 6,067,010 teaches the use of an auxiliary safety warning lamp system to enhance the visualization of the brake lights and/or turn signals for a vehicle. Nowhere within the Wang '010 reference are emergency vehicle warning light signals taught, suggested, and/or referenced. Nowhere within the Wang '010 reference are light emitting diodes taught, suggested, and/or referenced.

No suggestion, motivation or teaching is provided in the Wang '010 reference for use of a controller to produce at least two different types of visually distinct warning light signals in at least one pattern or at least one sequence of light signals. No suggestion, motivation, or teaching is provided in the Wang '010 reference for combination with any other reference to provide a controller to produce at least two different types of visually distinct warning light signals in at least one pattern or at least one combination of light signals.

The Walton '073 patent teaches the use of front and forward side mounted combination brake/running/turn signal supplemental lights which will provide a visible change in signal as the vehicle brakes or initiates a turn signal. The Walton '073 reference further teaches the use of light emitting diodes of different colors for connection to either the braking circuit and/or the turn signal circuits as an adaptation of an existing motor vehicle electrical system.

No suggestion, motivation, or teaching is provided in the Walton '073 reference for use of a controller constructed and arranged to produce at least two different types of visually distinct warning light signals in at least one pattern or at least one sequence of light signals. No suggestion, motivation, or teaching is provided in the Walton '073 reference for combination with any other reference to provide a controller utilized to produce at least two different types of visually distinct warning light signals in at least one pattern or at least one sequence of light signals.

In paragraph 6, the Examiner rejected claim 12 pursuant to 35 U.S.C. §103(a) as being unpatentable over Wang '010 in view of Walton '073 and Ishikawa U.S. Patent No. 5,594,415.

Applicant herein has withdrawn claim 12 from consideration without prejudice for future consideration within a continuation application. Additional analysis with respect to 35 U.S.C. §103 in view of Ishikawa '415 is therefore no longer necessary at this time.

No motivation is provided for combination of Wang '010 and Walton '073 in that warning signal light patterns not same problem to be solved as related to the enhancement of visualization of turn-signal indicators and/or brake lights and the integration of brake light or turn signal supplements into existing turn signal and/or brake

light circuits.

For the above-identified reasons, Applicant respectfully asserts that no motivation or suggestion is provided in either Walton '073 or Wang '010 for combination to teach Applicant's claims herein. Further, Applicant asserts that Wang '010 and Walton '073 may not be combined in an operative fashion to yield Applicant's invention herein. Existing brake light and/or turn signal circuitry is incapable of providing patterns or sequences of emergency warning light signals. Applicant further asserts that no motivation is present within either the Walton '073 nor Wang '010 references to address the problem of emergency and/or utility vehicle warning light systems and warning light signals and that the Walton '073 and Wang '010 references address the problem and solution as to the enhancement of turn signal indicators and/or brake lights for integration into existing turn signal and brake light circuits. Therefore, the Wang '010 and Walton '073 references are inapplicable to emergency vehicle warning signal lights and emergency vehicle warning signal light patterns or sequences as taught and claimed by Applicant herein. Further, Applicant respectfully asserts that the Examiner has impermissibly utilized hindsight to reject Applicant's claims herein. Applicant further asserts that the examination of Applicant's claims as amended herein are allowable when examined without the impermissible use of hindsight in view of the Walton '073 and/or Wang '010 references.

In paragraph 7, the Examiner indicated that the Information Disclosure Statement numbers 6 and 7 appear to have been lost during handling of the papers throughout the examination process, Applicant has therefore enclosed herein copies of information disclosure statements Papers No. 6 and 7 dated September 28, 2000, and May 2, 2001, along with transmittal documentation for consideration by the Examiner.

Applicant has attached hereto a "Marked-Up Copy of the Amended Claims" for consideration by the Examiner. The claims have been amended herein and/or canceled without prejudice.

For the above-identified reasons Applicant respectfully requests reconsideration and withdrawal of a 35 U.S.C. §103 rejection of Applicant's claims as amended herein. Applicant respectfully requests reconsideration and allowance of Applicant's claims 1, 2, 3, 4, 10, 11, 14, 16, 17, 18, and new claims 22 through 42 herein.

Issuance of an early Notice of Allowance is earnestly solicited. Should the Examiner have any questions concerning this Amendment and remarks, the Examiner is cordially invited to contact the undersigned via E-mail, facsimile, and/or by telephone at the below-identified addresses.

Please charge any deficiency of fees to Applicant's Counsel's Deposit Account Number 22-0350.

Respectfully submitted,
VIDAS, ARRETT & STEINKRAUS, P.A.

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VERSION WITH MARKINGS TO SHOW CHANGES TO THE CLAIMS

1. (Amended) A combination multiple warning signal light and motorized vehicle, the combination multiple warning signal light and motor vehicle comprising:

a) a plurality of strip light emitting diode light sources engaged to an exterior of said vehicle, each strip light emitting diode light source having a visible exterior surface;

b) a plurality of light emitting diodes arranged about and attached to the visible exterior surface of each strip light emitting diode light source; and

c) a controller in electric communication with the light emitting diodes, the controller constructed and arranged to selectively activate the light emitting diodes thereby producing [more than] at least two different types of visually distinct warning light signals, said controller being further constructed and arranged to produce the at least two different types of visually distinct warning light signals in at least one pattern of light signals, said light emitting diodes receiving power from a power source.

3. (Amended) The combination of claim [2] 1, each of said strip light emitting diode light sources comprising a back side having an affixation member.

10. (Amended) The combination of claim [7] 4, wherein the plurality of light emitting diodes are in the form of an array.

11. (Amended) The combination of claim [7] 4, wherein the plurality of light emitting diodes are selectively illuminated to create the appearance of rotation.

14. (Amended) The combination of claim [9] 4, wherein the warning light signal is a directional indicator.

16. (Amended) The combination of claim [7] 4, wherein the motorized vehicle is a utility vehicle.

17. (Amended) The combination of claim [7] 4, wherein the motorized vehicle is an emergency vehicle.

18. (Amended) The combination of claim [7] 4, further comprising a cover enclosing said light emitting diodes.